

REMARKS

Claims 1-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Saunders (Newcard Exposed) in view of Sleeman (US20040260843). These rejections are respectfully traversed for the reasons set forth below.

Claims 1, 11, and 21 include: "a second port electrically coupled to the second subsystem by a second connector, wherein the second port includes at least one high speed serial communications bus, the second subsystem including a user console having a power control providing a status signal to the first subsystem via the Newcard device; and

The USPTO recognizes that Saunders does not disclose a user console, and submits that the Sleeman console combined with Saunders provides a *prima facie* of obviousness.

The claims include "the second subsystem including a user console having a power control providing a status signal to the first subsystem via the Newcard device." The USPTO does not address this but merely relies on a console of Sleeman.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the Saunders patent alone, or in combination with Sleeman, do not teach "the second subsystem including a user console having a power control providing a status signal to the first subsystem via the Newcard device."

Therefore, it is impossible to render the subject matter of claim as a whole obvious based on the Saunders patent considered alone or in combination with the Sleeman patent, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1, 11, and 21, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Saunders and Sleeman patents cannot be combined and applied to reject claims 1, 11, and 21 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Saunders and Sleeman do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests providing "the second subsystem including a user console having a power control providing a status signal to the first subsystem via the Newcard device."

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 1, 11, and 21.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1, 11, and 21. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be

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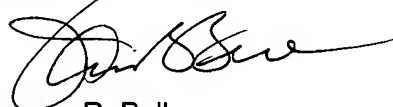
met with respect to claims 1, 11, and 21, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 11, and 21 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-22 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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